



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<i>In re</i> the application of	)	
Toshihiro SHIMA	)	Art Unit: 2152
Application No. 10/632,763	)	Examiner: B. Whipple
Filed: August 1, 2003	)	Atty. Docket No. MIPFP044
For: AUTO SETTING FOR NETWORK	)	Date: September 5, 2008
DEVICES	)	Confirmation No. 5047

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 5, 2008.

Signed: \_\_\_\_\_

Peter B. Martine

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejections set forth in the Final Office Action dated May 5, 2008. This request is being filed concurrently with a Notice of Appeal.

Claims 1 and 4-16 are pending in the subject application. Claims 1, 4-9, 11, and 14-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Matsuda et al.* ("Matsuda") (US 2002/0133573 A1) in view of *Traversat et al.* ("Traversat") (US 6,119,157). Claim 10 has been rejected based on the same combination applied against claim 1, and further in view of *Parthesarathy et al.* ("Parthesarathy") (US 6,353,926 B1). Claims 12 and 13 have been rejected based on the same combination applied against claim 1, and further in view of *Sherer et al.* ("Sherer") (US 6,115,376). As will be explained in more detail in the Argument section set forth below, the obviousness rejections are improper

because the Examiner has failed to establish a *prima facie* case of obviousness against the claimed subject matter because the asserted combinations of references do not disclose or suggest each and every feature of the claimed subject matter.

### **ARGUMENT**

#### **Argument No. 1: The *Matsuda* Reference Does Not Disclose or Suggest “Setting Information” as Specified in Independent Claims 1, 15, and 16**

The claimed subject matter, as defined in independent claims 1, 15, and 16, relates to the setting of setting information in a network device. As specified in claim 1, the setting information “is used for a preset control of the network device and includes unique information for a network device type.” Thus, the claimed “setting information” means the setting information for a device, which is irrelevant to the settings of a server. Specifically, the setting information includes information such as, for example, print quality and printing paper, which is specified for the operation of the device itself (and is different from general boot information).

The *Matsuda* reference does not disclose or suggest “setting information” as specified in the claimed subject matter. The configuration disclosed by *Matsuda* allows a server to search for boot information appropriate for a target client and transmit the boot information to the target client. The claimed setting information is not related to establishing network communication and, in fact, is useless in such an application. Instead, the characteristic feature of the setting information is to allow the settings of respective network devices to be made all at once.

In the “Response to Arguments” section of the Final Office Action, the Examiner states that “the features upon which applicant relies (i.e., boot information) are not recited in the rejected claim(s).” Final Office Action at page 2. The claimed configuration does not include boot information, and Applicant’s reference to “boot information” in the arguments

referred to by the Examiner was made to demonstrate that, even in the context of the boot information shown by *Matsuda*, the *Matsuda* reference does not disclose any technical concept similar to that of the claimed subject matter. Throughout the prosecution of the subject application, the claimed subject matter has been consistently characterized by its use of setting information including unique information for a network device type.

As neither the *Matsuda* reference nor the *Traversat* reference discloses or suggests “setting information” as specified in the claimed subject matter, the result of the combination of the *Matsuda* and *Traversat* references would not have included each and every feature of independent claims 1, 15, and 16. Accordingly, the combination of *Matsuda* in view of *Traversat* would not have rendered the subject matter defined in claims 1, 15, and 16 obvious to one having ordinary skill in the art.

**Argument No. 2: The *Traversat* Reference Does Not Disclose or Suggest the “Updating” Feature Specified in Independent Claims 1, 15, and 16**

In formulating the obviousness rejection, the Examiner acknowledges that the *Matsuda* reference does not disclose the “update module” specified in claim 1 (or the corresponding “updating” feature specified in claims 15 and 16). To remedy this deficiency, the Examiner relies on the *Traversat* reference as disclosing an “update module” as specified in claim 1 (see the Final Office Action at pages 4-5).

The *Traversat* reference discloses a technique for updating an application program. In this technique, a server broadcasts update information without waiting for a request from a personal computer (PC). Thus, even if no update information exists, both the application program and also the PC itself are operable.

On the other hand, as discussed above, the claimed subject matter relates to the setting of setting information in a network device. If the setting information is not set, then the network device does not operate, and the setting information is transmitted at the request of

the network device. As such, the *Traversat* reference does not disclose or suggest an update module having the functionality specified in claim 1 (or the corresponding “updating” feature specified in claims 15 and 16).

As neither the *Matsuda* reference nor the *Traversat* reference discloses or suggests the “updating” feature specified in the claimed subject matter, the result of the combination of the *Matsuda* and *Traversat* references would not have included each and every feature of independent claims 1, 15, and 16. Accordingly, the combination of *Matsuda* in view of *Traversat* would not have rendered the subject matter defined in claims 1, 15, and 16 obvious to one having ordinary skill in the art.

### **Argument No. 3: Dependent Claims**

Each of dependent claims 10, 12, and 13 ultimately depends from claim 1. In formulating the obviousness rejections for these dependent claims, the Examiner has relied upon two additional references, namely *Parthesarathy* and *Sherer*. Neither the *Parthesarathy* reference nor the *Sherer* reference, however, cures the above-discussed deficiencies of the combination of the *Matsuda* and *Traversat* references relative to the subject matter defined in independent claim 1. Accordingly, each of the dependent claims is patentable under 35 U.S.C. § 103(a) over the same combination of references applied against claim 1, and further in view of either the *Parthesarathy* reference or the *Sherer* reference for at least the reason that each of these claims ultimately depends from claim 1.

### **Conclusion**

For the reasons set forth above, the combination of *Matsuda* in view of *Traversat* does not disclose or suggest each and every feature of the subject matter defined in independent claims 1, 15, and 16. It is axiomatic that the prior art must disclose or suggest each and every feature of the claimed subject matter to establish a *prima facie* case of

obviousness under 35 U.S.C. § 103(a). Accordingly, the combination of *Matsuda* in view of *Traversat* does not raise a *prima facie* case of obviousness against the subject matter defined in the present independent claims.

In view of the foregoing, Applicant respectfully submits that claims 1 and 4-16 are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, Applicant's undersigned representative may be reached at (408) 749-6902. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP044).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, LLP

A handwritten signature in black ink, appearing to read 'P. B. Martine', with a long horizontal stroke extending to the right.

Peter B. Martine  
Registration No. 32,043

710 Lakeway Drive, Suite 200  
Sunnyvale, California 94085  
Customer No. 25920